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07/915,884 07/20/92 MATSUI

18N1/0613

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SUITE 500  
3000 K STREET, N.W.  
WASHINGTON, D.C. 20001-5109

T	40399/119
EXAMINER	

MARSCHEL, A

ART UNIT	PAPER NUMBER
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32

1807  
DATE MAILED:

06/13/94

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 11-29-93 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☐ Notice of References Cited by Examiner, PTO-892.
- ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
- ☒ Notice of Art Cited by Applicant, PTO-1449. (1 page)
- ☐ Notice of Informal Patent Application, PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐

Part II SUMMARY OF ACTION

1. ☒ Claims 1-16 and 18-22 are pending in the application.

Of the above, claims 8-15 are withdrawn from consideration.

2. ☒ Claim 17 has been cancelled.

3. ☒ Claims 2, 3, 7, 16, 18, 19, and 22 are allowed.

4. ☒ Claims 1, 4-6, and 20 are rejected.

5. ☒ Claim 21 is objected to.

6. ☒ Claims 1-16 and 18-22 are subject to restriction or election requirement.

7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

Applicants' arguments, filed 11/29/93, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Applicants have confusingly indicated what appears to be the incorrect amended status for most of the claims amended as filed 11/29/93. For example, claim 1 has been twice amended previously which makes the 11/29/93 amendment the third amendment to claim 1. Therefore claim 1 should have been indicated as being "Thrice amended". Similarly, claim 2 has been previously amended once, therefore making the 11/29/93 amendment to claim 2 the second amendment. Therefore claim 2 should have been indicated as being "Twice amended" instead of only "Amended". Other claims, amended 11/29/93, also contain an incorrect amended status. In the future, applicants are advised to indicate the proper amending status so as to avoid confusion and possibly error during the patent printing process at such time that claims are allowed.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112,

first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed.

The rejection based on the amendment to claim 1, lines 4-5, directed to high affinity binding of the BB homodimer is reiterated and maintained as set forth in the previous office action, mailed 6/29/93. Applicants argue that Figures 8 and 11 support the amendment to the claim 1. This is non-persuasive because of the broad scope of the phrase "high affinity". The cited Figures appear to support the binding of AA, AB, and BB homodimer with equivalent affinities but there is no written description in the specification as filed directed to "high affinity" either for AA, AB, or BB homodimer binding. Claim 1 cites preferential binding in line 3 but there is no disclosure that this is the same as "high affinity".

Claims 1 and 4-6 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the above objection to the specification.

Claim 20 is rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is enabling only for claims limited to the DNA of claim 21. This rejection is reiterated and maintained as set forth in the previous office action, mailed 6/29/93. Applicants argue that the sequence of the  $\beta$  PDGF receptor is disclosed in Yarden et al. This disclosure is essential subject matter for the practice of claim 20 as indicated in the previous office action. The lack of this sequence disclosure in the specification as filed supports this lack of enablement which is

required for essential subject matter. Applicants have not set forth any other enablement for this sequence other than via the cited publication. Applicants have not supported the concept that this sequence is well known because a single publication lacks support for such a concept as being well known. It is noted that this publication is cited in the disclosure as filed. It is however improper to enable essential subject matter by incorporation by reference of a printed publication. See the following paragraph. See M.P.E.P. §§ 706.03(n) and 706.03(z).

The incorporation of essential material by reference to a foreign application or foreign patent or to a publication inserted in the specification is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or applicant's attorney or agent, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. In re Hawkins, 486 F.2d 569, 179 USPQ 157; In re Hawkins, 486 F.2d 579, 179 USPQ 163; In re Hawkins, 486 F.2d 577, 179 USPQ 167.

Claim 21 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 1-7, 16, and 18-22 are allowable over the prior art of record because the  $\alpha$  PDGF receptor DNA and protein is neither taught nor suggested by the prior art of record.

Claims 2, 3, 7, 16, 18, 19, and 22 are allowed.

**THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS

ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

This application contains claims 8-15, drawn to an invention non-elected with traverse in Paper No. 8, filed 11/15/90 in the parent application serial number 07/308,282. A complete response to the final rejection must include cancellation of non-elected claims or other appropriate action (37 C.F.R. § 1.144) M.P.E.P. § 821.01.

Papers related to this application may be submitted to Group 1800 by facsimile transmission. Papers should be faxed to Group 1800 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

The CM1 Fax Center number is either (703) 305-3014 or (703) 308-4227.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703) 308-3894.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*AM*  
A. MARSCHEL:am

June 13, 1994

*Mindy B. Fleisher*  
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PRIMARY EXAMINER  
GROUP 1800